

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

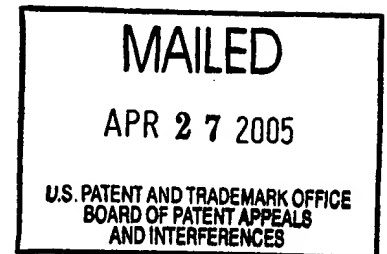
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte VINCENT T. KOZYRSKI
and DONALD B. EFFGEN

Appeal No. 2005-0879
Application No. 09/822,136

ON BRIEF



Before FRANKFORT, MCQUADE, and BAHR, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Vincent T. Kozyrski et al. appeal from the final rejection (mailed November 4, 2003) of claims 1, 4 through 6, 13 and 25 through 30, all of the claims pending in the application.

THE INVENTION

The invention relates to "hand-held rotary cutting tools for use with thin sheet materials" (specification, page 1).

Representative claim 1 reads as follows:

1. A hand-held rotary cutter for cutting thin sheet materials, comprising:
a handle having a hand grip portion; and

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a circular cutting blade having a cutting edge, a diameter, and a thickness, wherein the cutting blade is pivotally mounted to the handle, and the cutting edge includes an edge angle that is not less than forty degrees and not greater than fifty degrees;

wherein the diameter of the cutting blade is not greater than fifteen times the thickness.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Mathein	704,352	July 08, 1902
Jahn	5,235,748	Aug. 17, 1993

THE REJECTIONS

Claims 1, 4 through 6, 13 and 25 through 30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Mathein.

Claims 1, 4 through 6, 13 and 25 through 30 also stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Jahn.

Attention is directed to the brief (filed February 6, 2004) and answer (mailed July 1, 2004) for the respective positions of the appellants and examiner regarding the merits of these rejections.

DISCUSSION

As framed and argued by the appellants, the dispositive issue in the appeal is whether Mathein or Jahn would have rendered obvious a rotary cutter or rotary cutting blade meeting the limitations in independent claims 1, 13, 25 and 28 requiring a cutting edge angle "that is not less than forty degrees and not greater than fifty degrees." The appellants' specification (see pages 1 through 3) asserts that cutting edge angles within this range afford a higher degree of durability and safety as compared to sharper, smaller angle cutting edges, while still being effective for cutting thin sheet materials. These assertions find support in the 37 CFR § 1.132 Declarations of Vincent T. Kozyrski filed September 17, 2002 and September 29, 2003. The second Kozyrski declaration also indicates that cutting edge angles within the specified range are more effective for cutting thin sheet materials than duller, larger angle cutting edges.

Turning to the prior art applied by the examiner, Mathein discloses a rotary cutter comprising a rotary disk cutter L for trimming photographic prints, and Jahn discloses a rotary cutter comprising a circular cutter wheel 16 for severing foil seals on wine bottles. Neither reference conveys any information as to

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the cutting edge angle of these cutting implements beyond that which is depicted in their respective drawings.

In making the rejection based on Mathein, the examiner submits that

[i]t is acknowledged that dimensions may not be taken directly from patent drawings since they are not engineering drawings. However, "The drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art." In re Aslanian, 200 USPQ 500 (CCPA 1979), MPEP 2125. It would appear that Mathein suggests that the disc should be rather thick and have a rather large edge angle. Since this is within or similar to the [range] claimed, 40-50 degrees, . . . it would have been an obvious matter to set such [range] as being within normal parameters of conventionality dependent on the size of the blade, the material from which it is made, its rotating speed, what material is being cut, the developed friction, and how often it is desired to replace the blade [answer, pages 3 and 4].

The rejection predicated on Jahn has a similar rationale (see page 4 in the answer).

Rejections based on 35 U.S.C. § 103(a) must rest on a factual basis. In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. Id.

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In essence, the factual basis advanced by the examiner in support of the appealed rejections consists of Mathein's drawing of rotary disk cutter L and Jahn's drawing of circular cutter wheel 16. As urged by the examiner, things clearly shown in the drawings of a reference patent are not to be disregarded in assessing the patentability of a claim. In re Mraz, 455 F.2d 1069, 1072, 173 USPQ 25, 27 (CCPA 1972). On the other hand, as patent drawings generally are not working drawings drawn to scale, it is well established that they do not define the precise proportions of the elements shown therein and may not be relied on to show particular sizes if the specification is completely silent on the issue. Hockerson-Halberstadt Inc. v. Avia Group International Inc., 222 F.3d 951, 956, 55 USPQ2d 1487, 1491 (Fed. Cir. 2000).

In the present case, Mathein and Jahn do not discuss cutting edge angles or indicate that their drawings are to scale. Moreover, the drawings in these references are not so clear that they teach, or would have suggested, a cutting edge angle within the range set forth in the appealed claims. Indeed, by the examiner's own measurement,¹ Mathein's drawings show a cutting

¹ See the Office action mailed on July 29, 2003 which was incorporated by reference into the final rejection.

edge angle of approximately 68 degrees and Jahn's drawings show a cutting edge angle of approximately 60 degrees, both of which fall outside the range specified in the claims. These references also are devoid of any evidentiary support for the examiner's conjecture that it would have been obvious to provide Mathein's rotary disk cutter L or Jahn's circular cutter wheel 16 with a cutting edge angle "that is not less than forty degrees and not greater than fifty degrees" as recited in independent claims 1, 13, 25 and 28 based on the size, material, speed, durability and/or intended use of these components.

Thus, neither Mathein nor Jahn justifies a conclusion that the differences between the subject matter recited in independent claims 1, 13, 25 and 28, and dependent claims 4 through 6, 26, 27, 29 and 30, and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art. Accordingly, we shall not sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 4 through 6, 13 and 25 through 30 as being unpatentable over Mathein or the standing 35 U.S.C. § 103(a) rejection of claims 1, 4 through 6, 13 and 25 through 30 as being unpatentable over Jahn.

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SUMMARY

The decision of the examiner to reject claims 1, 4 through 6, 13 and 25 through 30 is reversed.

REVERSED

Charles E. Frankfort

CHARLES E. FRANKFORT
Administrative Patent Judge


JOHN P. MCQUADE
Administrative Patent J

JOHN P. MCQUADE
Administrative Patent Judge

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